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EXAMINER

COLE, LAURA C

ART UNIT

PAPER NUMBER

1744

DATE MAILED: 07/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/621,722

Applicant(s)

KAMMERER ET AL.

Examiner

Laura C Cole

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 6-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). 6.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other:

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Goldman, USPN Re. 16,869.

Goldman discloses a manicuring instrument that comprises a handle defining a longitudinal axis (1) and a cleaning head end (near the ferrule (6)) and a grasping end (1), the cleaning head end defining a securing region ((6), (7), (8)), a cleaning tip formed of a plurality of fibers that are rigid ((3); Page 1 Lines 49-56), the cleaning head secured to the handle at the cleaning head end (Figures 1-4), and the handle and tip defining a longitudinal axis (Figures 1-4).

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldman, USPN Re. 16,869.

Goldman discloses the claimed invention except for the bristle material being polyester. It would have been obvious for one of ordinary skill in the art at the time the invention was made to make the bristles from polyester, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of

its suitability for the intended use as a matter of obvious engineering choice. In re Leshin, 125 USPQ 416.

3. Claims 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldman, USPN Re. 16,869 in view of Varma, USPN 6,269,515.

Goldman discloses all elements above except for securing of the cleaning tip within a bore.

Varma discloses an apparatus for cleaning an electrode that comprises a handle that defines a longitudinal axis having a cleaning head and grasping end, wherein the handle is a hollow tubular member defining a central bore (550) and the cleaning tip (510) is formed with dimensions to fit within the bore (Column 3 Lines 20-30). The swab is non-bending (Column 2 Lines 30-35).

It would have been obvious for one of ordinary skill in the art to modify the securing arrangements, including the handle, for the securing structure of Varma so that a ferrule or extra securing band is not required thereby minimizing manufacturing costs and reducing the materials needed for manufacture.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldman, USPN Re. 16,869 in view of Kachigian, USPN 5,084,005.

Goldman discloses all previously mentioned elements, however does not disclose an ultrasonic welding process to secure the cleaning tip to the handle.

Kachigian discloses a swab that comprises a handle (Figures 1-3 (21)), a cleaning head (Figures 1-2 (33)), a grasping end (Figures 1-3 (29)), a securing region (Figure 4), and a cleaning tip (Figures 1-4 (32)) formed of a plurality of fibers. Further

Kachigian discloses (Column 5, Lines 41-48) that a swabbing tip may be secured to a rigid handle structure by ultrasonic welding.

It would have been obvious to one of ordinary skill in the art to use the method of securement by using ultrasonic welding as Kachigian teaches in order to keep debris, dust particles, or bacteria from the cleaning tip which can be disruptive in electro-mechanical components.

5. Claims 8, 9, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldman, USPN Re. 16,869 in view of Bozarjian, USPN 6,187,104.

Goldman discloses previously mentioned elements but does not disclose a tether.

Bozarjian discloses a cleaning implement and method that has a tether secured to the handle-grasping end (Figures 1, 2, and 4 (14), Column 3, Lines 7-13, and Column 3, Lines 60-65) and the tether is secured through a handle bore (Figure 1 (23)). The tether may be removable (Column 3, Lines 60-65) or permanent (Column 5, Lines 27-29.)

It would have been obvious for one of ordinary skill in the art to apply the teachings of Bozarjian in including a removable or permanent tether to the swab so that the swab is always nearby or on hand when cleaning.

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldman, USPN Re. 16,869 in view of Gradone, USPN 3,712,296.

Goldman discloses all previously mentioned elements, but does not disclose a tether disposed between an external gripping portion and the handle.

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Gradone discloses a swab device that has a handle (Figure 1 (10)), a cleaning head end (Figure 1 (12)), a grasping end (Figure 1 (14)), a securing region (shaded region of Figure 2), and a cleaning tip (Figure 1 (12)). Gradone further discloses a grip portion mounted externally (Figure 1 (16)) on the handle, the grip portion is provided so as to avoid human contact with the handle, which is desired in the medical field (Column 2 Lines 49-52).

It would have been obvious for one of ordinary skill in the art to attach an external grip portion to a handle, as it may be desired to avoid the possibility of transferring dust or human oils when working with electro-mechanical devices in a clean room.

7. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldman, USPN Re. 16,869 in view of Gradone, USPN 3,712,296, and in further view of Lisowski, USPN 5,937,473.

Goldman and Gradone disclose all previously mentioned elements, but do not disclose a tether disposed between an external gripping portion and the handle.

Lisowski teaches a tether or "wrist loop" (Figures 1-2 (17)) being disposed between a grip portion and handle.

It would have been obvious to one of ordinary skill in the art to add a tether to the swab devices of Goldman and Gradone so that the swab will always be nearby, hooked, or worn around the wrist.

### ***Applicants Arguments***

8. Applicant states:

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- A. The "Fiber-Pulling" limitation is a structural limitation and not merely a method.
- B. The polyester strips of Burrow and compressed fibers of the present invention are substantially different.
- C. Discko discloses a cleaning head capable of bending and that the bending capability does not create a substantially rigid cleaning head.
- D. One would not modify a dental brush's bristles to effectively dust fiber optics, Discko teaches away from modifying the cleaning head, and there is no suggestion in Discko or Gorthala to combine the two.
- E. Kachigian teaches that the handle is inserted *onto* the cleaning head instead of *into* the cleaning head as Applicant discloses.
- F. Bozarjian uses the tether in order to be connected to a mount, not a person.
- G. Gradone discloses the grip to prevent human contact with the handle *not* to prevent slipping as Applicant discloses.
- H. Claims 11-12 have three references applied to them and asserts that it is non-obvious since three references have been combined.

***Response to Arguments***

9. Applicant's arguments A and E-H filed 17 June 2003 have been fully considered but they are not persuasive.

A. The "pulltruding" or "pulling fibers through a die" limitation is a product-by-process claim. MPEP section 2113 recites, "Product-by-Process claims are not limited

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to the manipulations of the recited steps, only the structure implied by the steps.”

Goldman discloses “a substantially rigid, elongated cleaning head.”

E. Kachigian provides the teaching of using ultrasonic welding to secure the cleaning head as one of many known means of securing a cleaning tip to a rigid handle.

Further, Claims 1 and 7 do not require that the handle is hollow.

F. In response to applicant’s argument that the tether is for use in combination with a mount and not a person, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

G. In response to applicant’s argument that the grip is for use to prevent human contamination with a swab and not to prevent slipping, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).



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H. In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

10. Applicant's arguments B-D, see Paper No. 5, filed 17 June 2003, with respect to the rejection(s) of claim(s) 1-10 under Discko, Jr. USPN 5,001,803, Burrow et al., USPN 5,214,821, and Gorthala et al., USPN 6,007,655 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Goldman, USPN Re. 16,869.

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura C Cole whose telephone number is (703) 305-7279. The examiner can normally be reached on Monday-Thursday, 7am - 4:30pm, alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Warden can be reached on (703) 308-2920. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-8772 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

LCC

LCC

July 24, 2003

*Robert J. Warden, Sr.*

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